

**REMARKS**

This Application has been carefully reviewed in light of the Office Action mailed April 19, 2007 (“Office Action”). At the time of the Office Action, Claims 1-16 were pending in the Application. In the Office Action, the Examiner rejects Claims 1-16. Applicant amends Claims 1 and 2, and cancels Claim 9 without prejudice or disclaimer. Applicant does not admit that any amendments are necessary due to any prior art or any of the Examiner’s rejections. Applicant respectfully requests reconsideration and allowance of all pending claims.

**Section 112 Rejections**

The Examiner rejects Claim 1 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Applicant respectfully requests reconsideration and allowance of amended Claim 1.

**Section 102 Rejections**

The Examiner rejects Claims 1, 7-9 and 13 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,555,334 issued to Ohnishi, et al. (“*Ohnishi*”). Applicant respectfully requests reconsideration and allowance of Claims 1, 7-9 and 13.

Amended Claim 1 recites, in part, “wherein ... the receiving component is located away from the focus of the diffraction structure for the received light at the second wavelength.” *Ohnishi* fails to teach, suggest, or disclose this element of amended Claim 1. Instead, *Ohnishi* specifically teaches away from this element of amended Claim 1. “A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). (M.P.E.P. § 2141.02). Moreover, although the Supreme Court recently denounced the rigid application of the “TSM” test in *KSR v. Teleflex*, 127 S.Ct. 1727 (2007), the Federal Circuit has subsequently found a patent not obvious where the relevant prior art taught away from the claimed invention. *Takeda Chemical v. Alphapharm*, 2007 WL 1839698 (Fed. Cir. 2007).

*Ohnishi* teaches away from amended Claim 1. Specifically, *Ohnishi* states that “there **arises a necessity** for adjusting the diffracting direction in order that the plus-sign primary

diffracted light beam 108 resulting from the diffraction of the light beam outputted or emanated from the end face 5 of the optical fiber 4 by the diffraction grating 6 **can correctly be collected or concentrated** onto the light receiving surface of the light receiving device or photodiode (photodetector in more general sense) 7.” (Col. 6, ll. 52-60; emphasis added). *Ohnishi* continues by stating, “In this conjunction, it is however noted that when the position of the light receiving diode 7 is changed, disposition or orientation of the diffraction grating 6 **must** naturally be so adjusted that the diffracted light beam as selected can be **concentrated or focussed** onto the light receiving diode 7.” (Col. 8, ll. 3-8; emphasis added). Moreover, FIGURE 1 of *Ohnishi* clearly illustrates light beam 108 being focused onto light receiving diode 7. Thus, in several different instances, *Ohnishi* specifically teaches away from “the receiving component is located away from the focus of the diffraction structure for the received light at the second wavelength” as recited, in part, in amended Claim 1. Instead, *Ohnishi* specifically requires that the components be arranged so that the light beam 108 is focused on the light receiving diode 7. *Ohnishi* not only fails to teach, suggest, or disclose each and every element of amended Claim 1, but because it teaches away from amended Claim 1, it also cannot form the basis of a section 103 rejection.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of amended Claim 1. Claims 7-8 and 13 depend from Claim 1, shown above to be allowable. Claim 9 is canceled without prejudice or disclaimer. For at least these reasons, Applicant respectfully requests reconsideration and allowance of Claims 7-8 and 13.

### **Section 103 Rejections**

The Examiner rejects Claims 2-6 under 35 U.S.C. § 103(a) as being unpatentable over *Ohnishi* as applied to claim 1 above, and in view of U.S. Patent No. 5,787,215 issued to Kuhara, et al. (“*Kuhara*”).

The Examiner rejects Claims 10 and 11 under 35 U.S.C. § 103(a) as being unpatentable over *Ohnishi* as applied to claims 1 and 7 above, and in view of *Kuhara* and U.S. Patent No. 6,504,975 B1 issued to Yamagata, et al. (“*Yamagata*”).

The Examiner rejects Claim 12 under 35 U.S.C. § 103(a) as being unpatentable over *Ohnishi* as applied to claims 1 and 7 above, and in view of U.S. Patent No. 5,600,486 issued to Gal, et al. (“*Gal*”).

The Examiner rejects Claim 14 under 35 U.S.C. § 103(a) as being unpatentable over *Ohnishi* as applied to claim 1 above, and in view of Japanese Kokai Patent Application No. Hei 9[1997]-325246 to Saito ("*Saito*").

The Examiner rejects Claim 15 under 35 U.S.C. § 103(a) as being unpatentable over *Ohnishi* and *Saito* as applied to claims 1 and 14 above, in view of U.S. Patent Application Publication No. 2003/0007753 A1 to Hurt, et al. ("*Hurt*").

The Examiner rejects Claim 16 under 35 U.S.C. § 103(a) as being unpatentable over *Ohnishi* and *Saito* as applied to claims 1 and 14 above, and in further view of U.S. Patent No. 5,537,504 issued to Cina, et al. ("*Cina*"). Applicant respectfully requests reconsideration and allowance of all pending claims.

Claims 2-6, 10-12, and 14-16 depend from Claim 1, shown above to be allowable. Moreover, the primary reference of *Ohnishi* teaches away from the claimed inventions and therefore cannot be combined with any of the above-identified art references to form the basis of a Section 103 rejection. For at least these reasons, Applicant respectfully requests reconsideration and allowance of Claims 2-6, 10-12, and 14-16.

**CONCLUSION**


For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Samir A. Bhavsar, Attorney for Applicant, at the Examiner's convenience at (214) 953-6581.

Applicant believes no fees are due. However, the Commissioner is hereby authorized to charge any deficiency or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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